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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,691	12/08/2004	Kazuya Urata	1617.51	1349
24040	7590	05/16/2006	EXAMINER	
DENNIS G. LAPOINTE LAPOINTE LAW GROUP, PL PO BOX 1294 TARPON SPRINGS, FL 34688-1294			ZIMMERMAN, JOHN J	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/517,691

Applicant(s)

URATA ET AL.

Examiner

John J. Zimmerman

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) 6 and 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/8/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

OFFICE ACTION

Amendments and Responses

1. This Office Action is in response to the "RESPONSE AFTER NON-FINAL OFFICE ACTION" received February 24, 2006. Claims 1-17 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 5 and 7-13 recite an "ornamental article" without reciting any further description of what this "ornamental article" might be. Since a person may consider any functional or nonfunctional article to be pleasing to the eye, it is not clear what is (or is not) an "ornamental article". Claims 6 and 14-17 depend on independent "ornamental article" claim 5, but are not indefinite because they state what the "ornamental article" is.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshi (Japanese Publication 07-246562).

7. Hoshi discloses plating an alloy including 20-95 wt.% Cu, 5-50 wt.% Sn and 0.5-3 wt.% oxygen on super abrasive grains (e.g. see paragraph [0012]). Specific anticipating composition examples are found in Examples 1-3. In addition, the composition ranges of Hoshi overlap the applicant's composition ranges with sufficient specificity to anticipate the claimed composition. The super abrasive grain substrates can be ceramic materials to which a first plating has been applied (e.g. see paragraph [0032]). The composition of Hoshi falls directly in applicant's claimed range and barring evidence to the contrary, the color of the plating alloy would be inherent to the composition. Although Hoshi may not describe the plated grains as "ornamental", any article may be "ornamental". Any person observing the plated grains of Hoshi may find them pleasing to the eye. In any event, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

Art Unit: 1775

USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Allowable Subject Matter

8. Claims 6 and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. It would not have been obvious to one of ordinary skill in the art at the time the invention was made to apply the claimed composition to a "snap button".

Response to Arguments

9. Applicant's arguments (received February 24, 2006) with respect to the pending claims have been considered but are moot in view of the new ground of rejection applying Hoshi (Japanese Publication 07-246562). The new rejection is the result of an updated search of the claimed subject matter. Since the new rejection was not the result of applicant's amendments, this Office Action has not been made Final.

10. Applicant argues that the prior rejection applying Sugawara '979 should be withdrawn because the composition of the Cu-Sn-O layer of Sugawara changes in the vertical direction and thus the color would change as the surface is worn away making it unsuitable for ornamental products (e.g. see page 8 of applicant's response). The examiner notes that the pending claims do not require a homogeneous distribution of elements in the plating layer and therefore applicant's arguments are not commensurate with the pending claim language. In addition, no factual

Art Unit: 1775

evidence has been provided by applicant that platings having composition gradients are not suitable for ornamental articles. The Sugawara reference, however, has been withdrawn because Sugawara's oxide layer would not be considered to be an "alloy" as the term is generally understood by one of ordinary skill in the art (e.g. see cited - A Dictionary of Metallurgy, "alloy") since it would not possess metallic properties and there is no indication that the oxide content Cu-Sn-O layer of the oxide layer would inherently fall within applicant's claimed range or should be optimized to fall within the claimed range.

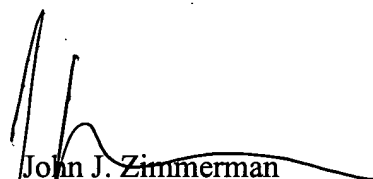
Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional art of record serves to further establish the level of ordinary skill in the art at the time the invention was made.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1775

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
May 15, 2006